

35 USC 102

Claim 1 is rejected pursuant to 35 USC 102(e) as being anticipated by Beswick et al (US 7,091,237). In the interest of expediting prosecution of this application, Applicants have canceled Claim 1, thereby obviating the rejection under 35 USC 102(e). Applicants respectfully request withdrawal of this rejection.

35 USC 103

Claims 1, 46-48 and 5—55 are rejected under 35 USC 103(a) as being allegedly obvious in light of Beswick. Applicants have canceled claim 1 in the interest of expediting prosecution, thereby rendering the obviousness rejection of Claim 1 now moot.

Applicants submit that the remaining claims directed to compounds and uses wherein the limitations of the present base claim (Claim 4) provide compounds and methods of use depending therefrom that are both novel and in no way suggested by the Beswick patent. Any characterization of the compounds of Claim 4 as alleged to be obvious would require improper hind sight reconstruction. However, it is well-established that hind sight obviousness analysis is not the proper standard. Applicants courteously maintain that the presently claimed compounds are both novel and non-obvious in light of the Beswick reference. Further, the present Claim 4, acknowledged by the Examiner to be patentable if written in independent form, discloses novel compounds claiming alkoxy, aryloxy, and arylalkyl at the R4 position, as well as numerous additional differences among the various, numerous substituents.

Applicants respectfully request that the method of use claims be allowed, commensurate in scope with the allowable Claim 4. As set forth *In re Ochiai*, 71 F.3d 1565, 37 USPQ 1127 (Fed. Cir. 1995), rejoinder of product claims with process claims commensurate in scope with the allowed product claims is permitted following a finding that the product claims are allowable. Applicants maintain that the use of patentable compounds is properly deemed both novel and non-obvious in light of the novelty and non-obviousness of the compound per se.

Applicants respectfully submit that the rejection under 35 USC 103 as applied to claims 46-48, and 50-55 may properly be withdrawn. Applicants request favorable reconsideration.

Claim Objections

Applicants note the Claim 4 has been written in independent form and the remaining objected claims now depend in directly or indirectly from Claim 4. Applicants believe that the claims are now in proper form for allowance, and request favorable reconsideration.

Remarks

The amendments are requested to place the application in condition for allowance. Applicants maintain that the amendments to the claims incorporate dependencies from claims set forth in the original applications. Applicants respectfully request correction of Claim 4 wherein

the word “and” should properly be replaced with the word “or”. Applicants believe that such correction should not introduce new matter.

Applicants request prompt reconsideration and passage of the application to issue.

The Examiner is respectfully requested to contact the undersigned attorney for any matters related to this application.

Respectfully submitted,

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